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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/050,640      | 01/16/2002  | Brian Anderson       | 1310/5-1            | 7581             |

7590 07/21/2004

FRANK C. NICHOLAS  
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EXAMINER

JANVIER, JEAN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3622

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/050,640

Applicant(s)

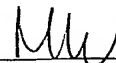
ANDERSON ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The title of the invention should be descriptive, brief and technically accurate under 37 CFR 1.72.

Furthermore, the Summary of the invention should not be a mirror image or replica of the Abstract of the disclosure. The Summary of the invention should instead represent a synopsis of the invention.

### ***Status of the claims***

Claims 15-32 are currently pending in the Instant Application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 15-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ikeda et al., US Patent 5,937,391A.

As per claims 15-32, Ikeda et al. disclose a point-service system for issuing points to a customer for purchases made at various stores (merchants Internet stores) within an online shopping mall comprising a points issuing unit 1 of fig. 1 for issuing points based on purchase amounts of the customer (col. 3: 52-53), a points management unit 2 of fig. 2 for storing the points accumulated by the customer and a points redeeming unit 3 of fig. 1 for reducing a purchase amount of the customer upon redeeming points at any participating store within the mall. This system eliminates the need for customer to carry a magnetic card and shorten a time from issuing points to redeeming points. In one embodiment, Ikeda et al. disclose a service system wherein a specific customer makes a request to buy goods from a home page of an online shopping mall and in response to this request, the service system (server) causes the number of effective points accumulated of the customer issued by a plurality of shops for each purchase made at each respective shop (merchant Internet store) to be displayed on the customer terminal by referring to the data of each shop forming part of the online shopping mall. If the customer still decides to order a product (continue with the transaction), he can click on a shopping button associated with one of the displayed shops to subsequently access an order button and. hence, the point-service system or service system linked to a web server of the online shopping mall is activated to issue points or redeem points at the customer request or instructions when he inputs an order (see abstract; col. 2: 10-67; figs. 1-19). It is to be understood that a customer can explicitly or implicitly make a request from the point-service system to buy a product

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from a participating shop, redeem points or simply query the point-service system database for the effective points accumulated to date. The point service system keeps track of the customer's transaction (history) including points issued to the customer, points redeemed by the customer, the shops or Internet stores that issue the points, shops that redeem the points, the customer's effective total points, points that are about to be expired, etc. (tracking program-figs. 5-10 and 14-20). See (col. 5: 22-38; col. 4: 34-40; col. 10: 55 to col. 11: 3).

Additionally, Ikeda et al. further disclose a point-service system for issuing points to a customer for purchases made at various stores within an online shopping mall wherein the point-service system detects customer's points close to expiration (block S11) of fig. 10 and if there are points close to expiration, then the customer will be notified and requested that the customer take appropriate actions, (block S12) of fig. 10, and in the event the customer fails to use these points before the expiration date, the point-service system nullifies or subtracts these points from the total accumulated points so as to arrive at an updated total collected points (col. 9: 24 to col. 10: 2; col. 10: 55 to col. 11: 3).

Moreover, the customer can access the online shopping mall to check his or her number of points and purchase history. If the customer is assigned an electronic mail (e-mail) address, then the current number of points can be periodically transmitted from the online shopping mall or points service system to the customer (broadly interpreted, this reads on sending a personal or targeted e-mail to the customer -Col. 4:40).

Here, Ikeda further discloses a mail process can be performed by either automatically sending the mail after preparing an electronic mail statement or printing a notification on a printer and normally mailing the notification. The points management

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table stores a mail ID required in the automatic sending process, or a postal code and address required in the normal mailing process. In any case, a mailing process is exclusively performed in step S12. It is not confirmed in step S12 whether or not a notification is actually transmitted to the customer, or whether or not the customer has actually received a notification (fig. 10).

### **Conclusion**

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 138, 911 to Fredregill discloses a computer implemented consumer transaction point accumulation system in which a consumer earns and accumulates points immediately for immediate use during transactions at participating retailer outlets, wherein at each transaction, a customers identification number is transmitted to a host data base which stores customer records including a customer balances of points accumulated to date. The system processing each consumer transaction during the consumer visit to the retailer outlet to determine points awarded for each transaction and to determine whether the item purchased is a redeemable item for which points may be redeemed for a reduction of the price of the redeemable item. The system updating said customer records immediately by adding points awarded or subtracting points redeemed from the customer balance of transaction points (See abstract).

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113


. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

A handwritten signature in cursive script, appearing to read "Jean D. Janvier".

JDJ

07/12/04